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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DOUGLAS B. QUINE and KARL H. SCHUMACHER

Appeal 2008-0685
Application 10/017,241
Technology Center 2100

Decided: June 25, 2008

Before LANCE LEONARD BARRY, ST. JOHN COURTENAY III, and
STEPHEN C. SIU, *Administrative Patent Judges*.

SIU, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's
Final Rejection of claims 1-29. We have jurisdiction under 35 U.S.C.
§ 6(b). We affirm-in-part.

A. INVENTION

The invention at issue involves correcting addresses of erroneously addressed electronic messages (Spec. 1). In particular, the domain portion of an e-mail address is parsed and the e-mail address is checked against a format rule or requirement corresponding to the domain (*id.* 4).

B. ILLUSTRATIVE CLAIM

Claim 1, which further illustrates the invention, follows:

1. A method for correcting an e-mail address, the method comprising:
 - parsing a domain portion of the e-mail address;
 - identifying a format requirement corresponding to the domain portion in a domain name database; and
 - providing a format suggestion based on the identified format.

C. REJECTION

Claims 1-5, 8-21, and 24-29 stand rejected under 35 U.S.C. § 102(e) as being unpatentable over U.S. Patent Publication No. 2002/0065891 (“Malik”). Claims 6, 7, 22, and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Malik and U.S. Patent No. 6,829,607 (“Tafoya”).

II. CLAIM GROUPING

When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal

with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately.

37 C.F.R. § 41.37(c)(1)(vii) (2006).¹

Appellants argue claims 1, 3, 9, 12-14, 16-21, and 24-29 as a first group (App. Br. 18-22) and claims 6, 22, and 23 as a second group (App. Br. 23, 25). Appellants argue each of claims 2, 4, 5, 7, 8, 10, 11, and 15 separately (App. Br. 21-25). We select claim 1 as the sole claim on which to decide the appeal of the first group and claim 6 as the sole claim on which to decide the appeal of the second group. We decide the appeal of each of claims 2, 4, 5, 7, 8, 10, 11, and 15 separately.

III. CLAIMS 1, 3, 9, 12-14, 16-21, AND 24-29

Appellants assert that “Malik ‘891 does not teach or fairly suggest identifying a format requirement” (App. Br. 20).

While Appellants indicate one example of a format requirement from the Specification “to include an abstract format rule . . . such as ‘first.last’ or

¹ We cite to the version of the Code of Federal Regulations in effect at the time of the Appeal Brief. The current version includes the same rules.

‘LLLLLFF’” (App. Br. 20), we do not find, and Appellants do not indicate, an explicit definition of the term “format requirement” in the Specification.

“[T]he PTO gives claims their ‘broadest reasonable interpretation.’” *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)). “[T]he words of a claim ‘are generally given their ordinary and customary meaning.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (internal citations omitted). “[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application.” *Phillips*, 415 F.3d at 1313.

In the absence of an explicit definition, we adopt an ordinary and customary meaning of the term “format requirement” to include rules (i.e., “requirement”) for a necessary way of presenting or organizing an item (i.e., “formatting”). Also, domain names include letters or symbols that are arranged or organized in a predetermined arrangement or order. The predetermined arrangement or order is based on “format requirements” (e.g., spelling rules/requirements). Based on this broad but reasonable interpretation, we agree with the Examiner that Malik discloses a “format requirement.” Because Malik discloses detecting “mistyped domain names” (¶ [0039]), and mistyped domain names include misspelled words (i.e., names that include letters or symbols that are organized erroneously) or words “according to basic grammar rules” (¶ [0040]), we find that detecting

the mistyped domain names includes applying rules (i.e., “requirements”) of letter/symbol arrangement (i.e., “format”).

For at least the aforementioned reasons, we conclude that Appellants have failed to demonstrate that the Examiner erred in rejecting claim 1. Therefore, we affirm the rejection of claim 1 and of claims 3, 9, 12-14, 16-21, and 24-29, which fall therewith.

IV. CLAIM 2

Appellants assert that “Malik ‘891 does not teach or describe an identified format requirement, or determining whether the identifier portion is consistent with the identified format requirement” (App. Br. 21).

As set forth above, we find that Malik discloses applying spelling or grammar rules to the domain names. Because spelling or grammatical structure of domain names includes organizing letters or symbols in a predetermined order or arrangement (i.e., “format”), we agree with the Examiner that Malik discloses an “identified format requirement.”

It follows that Appellants have failed to demonstrate that the Examiner erred in rejecting claim 2. Therefore, we affirm the rejection of claim 2.

V. CLAIM 4

Appellants assert that “Malik describes only usernames . . . and does not teach or fairly suggest using a name” (App. Br. 21).

We broadly but reasonably construe the term “name” to include the ordinary and customary meaning of any identifier by which something is known. Appellants indicate that Malik discloses “usernames.” Because a username includes an identifier by which “something is known,” we find that a username is equivalent to a “name” as recited in claim 4.

It follows that Appellants have failed to demonstrate that the Examiner erred in rejecting claim 4. Therefore, we affirm the rejection of claim 4.

VI. CLAIM 5

Appellants assert that “Malik ‘891 does not teach or suggest using a person’s name . . . but rather . . . describes only a username lookup without any description of first or last names” (App. Br. 21).

As set forth above, we find that Malik discloses a “name.” Therefore, we affirm the rejection of claim 5.

VII. CLAIM 8

Appellants assert that “Malik ‘891 does not teach or describe providing a suggested correction or an identified format requirement” (App. Br. 22).

Malik discloses a database containing domain names and “detecting whether a user-provided domain name is similar to one or more domain names stored in the domain name database to perform a spell-checking

operation” (¶ [0040]). Because Malik “provides” (i.e., makes available) the correctly spelled domain name and checks domain names against the correctly spelled domain name in the database, we find that Malik discloses “providing a suggested correction,” the correctly spelled domain name being a “suggested correction” that is provided or made available by the database.

It follows that Appellants have failed to demonstrate that the Examiner erred in rejecting claim 8. Therefore, we affirm the rejection of claim 8.

VIII. CLAIM 10

Appellants assert that “Malik ‘891 does not discuss in any way the name of an addressee, but describes only usernames” (App. Br. 22).

As set forth above, we find that Malik discloses a “name.” Therefore, we affirm the rejection of claim 10.

IX. CLAIM 11

Appellants assert that “Malik ‘891 describes gathering domain and email address usage data, not addressee information” (App. Br. 22).

Because Malik discloses addressee information including “names, addresses, telephone numbers, facsimile numbers, . . . of persons whom the user may intend to contact” (¶ [0044]), and any of the information disclosed by Malik constitute “addressee information” (i.e., any data pertaining to the

addressee), we disagree with Appellants' assertion that Malik fails to disclose "addressee information."

Therefore, we affirm the rejection of claim 11.

X. CLAIMS 6, 22, AND 23

Appellants assert that claim 6 depends from claim 1 "and is patentable for at least the same reasons described . . . with reference to those claims [claim 1]" (App. Br. 23).

Because Appellants have not demonstrated that the Examiner erred in rejecting claim 1, we affirm the rejection of claims 6, 22, and 23, which depend therefrom.

XI. CLAIM 15

Appellants assert that "Malik '891 does not teach or suggest 'providing a preferred alternative spelling for the domain portion based on whether the second format requirement for the one or more known alternative domain spellings is consistent with the identifier portion of the e-mail address" (App. Br. 22).

"[A]nticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. . . ." *In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) (citing *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984)).

"[A]bsence from the reference of any claimed element negates anticipation."

Kloster Speedsteel AB v. Crucible, Inc., 793 F.2d 1565, 1571 (Fed. Cir. 1986).

The Examiner finds that Malik discloses this feature at ¶ [0037] and ¶ [0049]. Malik discloses extracting “the domain name from the proposed recipient’s e-mail address . . . and [checking] the provided domain name” (¶ [0037]) and, “[i]f the e-mail address is not present in the address directory memory, the checker 71 generates a prompt” (¶ [0049]). However, the Examiner does not demonstrate that Malik also discloses “providing a preferred alternative spelling for the domain portion based on whether the second format requirement . . . is consistent with the identifier portion of the e-mail address” as recited in claim 15. The absence of this feature negates anticipation.

Therefore, we reverse the anticipation rejection of claim 15.

XII. CLAIM 7

Appellants assert that “there is nothing in the cited passage of Tafoya ‘607 suggesting utilizing a statistical frequency of the known names to determine a score relating to whether the identifier portion is consistent with one or more known names under the identified format requirement” (App. Br. 25).

As set forth above, Malik discloses receiving an e-mail address and matching the domain name of the e-mail address with stored domain names (i.e., spell-checking). Tafoya discloses “populating [a] resolution list” where

“the frequency of use and the time since last sending to . . . are . . . considered in ‘weighting’ the entries in the resolution list” (col. 4, ll. 57-62). However, the Examiner has not demonstrated that Malik and Tafoya also disclose a statistical frequency of names to determine “whether the identifier portion is consistent with . . . known names under the identified format requirement” as recited in claim 7.

Malik discloses a “spell-checking operation” (§ [0039]) in which the “format requirement” is the correct spelling of a domain name but does not appear to disclose performing the spell-checking operation using a statistical frequency of the known names. Rather, when a spelling match is found in Malik, the domain name is presumed to be valid but when a match is not found, the domain name is presumed to be invalid. The spelling of a domain name in Malik either matches the spelling of domain name in a database or it does not. Applying statistical frequency analysis appears to be unnecessary and unrelated to determining spelling matches. Therefore, we do not find that one of ordinary skill in the art would have incorporated the use of statistical analysis to determine if a domain name is spelled correctly.

Therefore, we reverse the rejection of claim 7.

XIII. ORDER

In summary, the rejection of claims 1-5, 8-14, 16-21, and 24-29 under § 102(e) and the rejection of claims 6, 22, and 23 under § 103(a) are

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affirmed. The rejections of claim 15 under § 102(e) and of claim 7 under § 103(a) are reversed.

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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